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Shelley M Beckstrand PC  
Attorney At Law  
314 Main Street  
Owego, NY 13827

EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/632,341

Applicant(s)

JORDAN ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003 ~~1930~~.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 9/30/03. Claims 1-19 and 22-27 are pending. Claims 20-21 and 28 have been cancelled.

***Allowable Subject Matter***

2. The indicated allowability of claims 1-7, and 10-11 is withdrawn in view of the newly discovered reference(s) to Feurer et al ("Performance Measurement in Strategic Change"). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 4-5,8-9,12-15 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed toward non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test:

- (1) whether the invention is within the technological arts;
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as

opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In this case, claims 4,8,12 and 17 recite abstract ideas. The recited steps of identifying goals, building a model, performing analysis, implementing tools, and generating metrics do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to define the measures of performance of a customer information technology organization.

Furthermore, mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole. In the present case of exemplary claim 4, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the trivial recitation of technology to store and/or retrieve data. Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the steps of the claimed invention. In other words, it is unclear how technology is involved producing a result of the claimed invention or how technology is used in the claimed inventive steps of providing target future business capabilities work product, translating customer goals into a model work product..., building said measurement model work product by building a first and second draft measurement model, building said first draft measurement model by executing first and second

prioritization processes, and building a second draft measurement model by selecting prioritized measures.

A similar analysis may be applied to claim 8, which also trivially recites the use of technology (i.e. the use of a computer database to store information), but does clearly recite how technology is involved producing a result of the claimed invention or how technology is used in the claimed inventive steps of selecting from the file contract measurements building a measurement model by building a first and second draft measurement model, building said first draft measurement model by executing first and second prioritization processes, building a second draft measurement model by selecting prioritized measures, implementing contract measurement models, and using and maintaining the contract measurements.

A similar analysis may also be applied to the mention of technology in claim 12. None of the recited steps are directed to anything in the technological arts as explained above with the exception of the trivial recitation of technology to store and/or retrieve data. Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the steps of the claimed invention. Thus it is unclear how technology is involved producing a result of the claimed invention or how technology is used in the claimed inventive steps of building said measurement model by building a first and second draft measurement model, building said first draft measurement model by executing first and second prioritization processes, building a second draft measurement model by selecting prioritized measures, validating assumptions and behavioral expectations and transferring to said

customer, resources and assets for implementing said measurement solution as validated.

Similarly, in claim 17, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the trivial recitation of technology to store and/or retrieve data. Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the steps of the claimed invention. In other words, it is unclear how technology is involved producing a result of the claimed invention or how technology is used in the claimed inventive steps of building a measurement model by building a first and second draft measurement model, building said first draft measurement model by executing first and second prioritization processes, building a second draft measurement model by selecting prioritized measures, identifying nonproductive measurements and identifying the impact to an organizational structure and processes of said customer of said measurement gaps.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces measurement reports and definitions.

Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 4,8,12 and 17 are deemed to be directed to non-statutory subject matter.

Claims 5, 9,13-15 and 17 inherit the deficiencies of their respective independent claims through dependency and are therefore also rejected.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. The previous rejections of claims 8-9,12-15,17,18,19,22,25, and 27 under 35 U.S.C. 112, second paragraph, are hereby withdrawn due to the amendment filed 9/30/03.

7. Claims 6-7,10-11, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In exemplary claim 6, it is unclear whether the applicant intends to claim a system or a method. While the preamble recites "a system for creating..." and the system includes a computer, the system also recites first and second prioritization processes. The Examiner understands the term "process," to mean a series of steps, and not an element or system component. Thus, it is unclear to the Examiner how the prioritization processes relate to the claimed system. In other words, it is unclear whether the claimed processes are software components, tangibly embodied on computer media or if the applicant intends to claim "means for performing a first prioritization process..." and "means for performing a second prioritization process."

A similar analysis may be applied to claims 10 and 16, which also recite a first and second prioritization process among the list of system components.

Claims 7 and 11 inherit the deficiencies of claims 6 and 10 through dependency and are therefore also rejected.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-7, 10-17, and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. ("The Information System Consultant's Handbook: Systems Analysis and Design", CRC Press) in view of Feurer et al ("Performance Measurement in Strategic Change")

(A) As per claim 1, Davis teaches a method for defining the measure of performance of an information technology organization, comprising;

a) an interviewing technique to identify customer goals of a system including behaviors exhibited in meeting the goals (Davis; section 8.2, paragraphs 1-2);

b) building a model in response to the customer requirements (i.e., goals) in such a manner that it is possible to test the finished system (i.e., metrics) (Davis; section 35.1, lines 1-4 and sections 75.1 and 75.3);

c) creating a data flow diagram of the old system (i.e., determining the metrics already collected) (Davis; section 3.4.1.2, lines 1-4);



d) creating a model of the new system based off of the old model including adding new requirements and elimination redundancies (i.e., identifying new data collection sources for data not already collected) (Davis; section 3.4.1.3, lines 1-5, section 24.4.7.2, lines 1-4 and section 75.4);

e) implementing/developing the system (i.e., gathering the metrics) (Davis; section 74.4.5 and section 72.4.1, lines 11-13); and

f) generating test data (i.e., measurement reports) (Davis; sections 75.1 and 75.4.5).

Claim 1 further recites that the step of building a measurement model in response to customer performance goals further comprises:

- building said first draft measurement model (Davis; Figure 31.1, and section 31.4; 74.4.4.7)
- building said second draft measurement model (Davis; section 31.4.1-31.4.2 and Figure 31.1). (i.e. building second, third, nth models)

Davis discloses iterative model creation (i.e. building first and second draft measurement models), but does not expressly disclose executing a first prioritization process determining for each metric a relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with each other metric. Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17,26-31,34-38) At the time of the Applicant's invention, it would have been obvious to

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one of ordinary skill in the art to modify the teachings of Davis with the teachings of Feurer. As suggested by Feurer, one would have been motivated to include these features so that the resultant system and method reflects the values of the customers (e.g. stakeholders) while establishing the right balance between conflicting goals.

(Feurer: par. 1)

(B) As per claim 2, Davis teaches selecting test data to ensure the system meets the user's needs (i.e., selecting metrics which satisfy prioritized behavior) (Davis; section 74.4 and section 35.4.1, lines 1-7).

(C) As per claim 3, Davis teaches non-behavior requirements and selecting test data (Davis; section 74.4 and section 35.4.1, lines 7-9).

(D) As per claim 4, Davis teaches a method for creating a measurement model product comprising;

a) providing a methodology (i.e., future capabilities work product) for defining goals and measurements (Davis; section 35.1, section 3.1 and section 74.3); and

b) translating the customer goals into a logical and physical model that defines desired behaviors and measures that test the behavior (i.e. measurement model work product) (Davis; Figures 35.1-35.3, section 35.4.1, section 35.4.3.1, lines 1-21 and sections 74.1 an 74.4.1).

Claim 4 further recites the step of building a measurement model work product further comprising:

- building said first draft measurement model (Davis; Figure 31.1, and section 31.4; 74.4.4.7)
- building said second draft measurement model (Davis; section 31.4.1-31.4.2 and Figure 31.1). (i.e. building second, third, nth models)

Davis discloses iterative model creation (i.e. building first and second draft measurement models), but does not expressly disclose executing a first prioritization process determining for each metric a relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with each other metric. Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17,26-31,34-38) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Davis with the teachings of Feurer. As suggested by Feurer, one would have been motivated to include these features so that the resultant system and method reflects the values of the customers (e.g. stakeholders) while establishing the right balance between conflicting goals. (Feurer: par. 1)

(E) As per claim 5, Davis teaches the step of determining the deficiencies in organization measurement processes by examining the old system versus the new system requirements (Davis; sections 3.4.1.1-3.4.1.4 and sections 74.1 and 74.4.1).

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(F) As per claim 6, Davis teaches a system for creating and using a measurement model work product, comprising:

a) a requirements specification (i.e., future business capabilities work product) for defining customer goals and test data (Davis; sections 25.1, 74.1, and 74.4.1); and

b) a requirements specification and test plan (i.e., measurement model) for translating customer goals into specific behaviors and measures that demonstrate the behaviors (Davis; section 35.4.1, 35.4.3.1, lines 1-21 and sections 74.1 and 74.4.1).

Davis further discloses that the system for iterative model creation (i.e. building first and second draft measurement models) has the following capabilities (i.e. the system comprises components to perform the following):

- building said first draft measurement model (Davis; Figure 31.1, and section 31.4; 74.4.4.7)
- building said second draft measurement model (Davis; section 31.4.1-31.4.2 and Figure 31.1). (i.e. building second, third, nth models)

Davis does not expressly disclose that the system executes a first prioritization process determining for each metric a relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with each other metric. Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17,26-31,34-38) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Davis with the teachings of Feurer to

include a first and second prioritization process. As suggested by Feurer, one would have been motivated to include these features so that the resultant system and method reflects the values of the customers (e.g. stakeholders) while establishing the right balance between conflicting goals. (Feurer: par. 1)

(G) As per claim 7, Davis teaches

c) creating a model of the new system based off of the old model including adding new requirements and elimination redundancies (i.e., identifying possible deficiencies in organizational measurement processes) (Davis; sections 3.4.1-3.4.4, section 24.4.7.2, lines 1-4 and section 75.4).

(H) As per claim 10, Davis teaches a system for formulating measurement requirements that are to be implemented in an engagement, comprising:

a) a structured analysis for detailing a current system and data flow diagram for detailing in a computer database data flow of data collected and reported (Davis; section 3.4.1.1-3.4.1.2 and sections 24.4.6.1-24.4.6.3 and 24.4.11);

b) a requirements specification (i.e., measurement model work product) for translating customer goals into specific behaviors and measures that demonstrate the behavior (Davis; Figures 35.1-35.3, and 5.1, sections 35.4.1, 35.4.3.1, lines 1-21 and section 74.1 and 74.4.1); and

c) a gap analysis work product for creating a model of the new system based on the model of the old system including adding new requirements and elimination redundancies (i.e., defining in said computer database differences between current

measures and new required measures) (Davis; section 3.4.1.3, lines 1-5, sections 24.4.6.1-24.4.6.3, 24.4.7.2 and section 75.4).

d) a computer for deriving the measurement model work product from iterative prototyping (i.e. first and second draft measurement models) (Davis: sections 5.1, 5.3-5.4.3, 35.6)

Davis further discloses that the system for iterative model creation (i.e. building first and second draft measurement models) has the following capabilities (i.e. the system comprises components to perform the following):

- building said first draft measurement model (Davis; Figure 31.1, and section 31.4; 74.4.4.7)
- building said second draft measurement model (Davis; section 31.4.1-31.4.2 and Figure 31.1). (i.e. building second, third, nth models)

Davis does not expressly disclose that the system executes a first prioritization process determining for each metric a relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with each other metric. Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17,26-31,34-38) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Davis with the teachings of Feurer to include a first and second prioritization process. As suggested by Feurer, one would have been motivated to include these features so that the resultant system and method

reflects the values of the customers (e.g. stakeholders) while establishing the right balance between conflicting goals. (Feurer: par. 1)

(I) As per claim 11, Davis teaches, the system as rejected in claim 10 further comprising:

- a) a user interface design (i.e., documenting expectations for data collection) (Davis; section 48.3, lines 1-15 and section 48.4.4.1, lines 1-14);
- b) a tool for configuring tools to implement requirements (Davis; section 35.4.3.4 and section 5.4.4, 5.4.1.9,);
- c) a requirements specification and system flow chart to define behavioral expectations (Davis; section 35.4.3.4 and Figure 37.4); and
- d) a report for visualizing the requirements (Davis; section 75.4.5.3, section 75.1, lines 1-2, section 75.4.5, lines 6-12 and section 4.4.2.3).

(J) As per claim 12, Davis teaches a measurement and performance management method, comprising:

- a) developing in a computer database a measurement solution during a proposal phase (Davis: sections 24.4.6.1-24.4.6.3; 35.4.3.4; and section 35.6; section 3.4.1.7; 5.1, 5.3-5.4.3, and section 1.4.4, lines 1-28)
- b) validating assumptions and expectations in the solutions during a feasibility phase (i.e., due diligence) (Davis; section 13.4.2, 13.4, line 1-6, table 13.1); and

c) transferring to user the resources and assets for implementing the measurement solution during a transfer phase (Davis; Figure 13.1, section 76.3, 76.4.4 and 76.4.5).

Claim 12 further recites the step of building a measurement model work product further comprising:

- building said first draft measurement model (Davis; Figure 31.1, and section 31.4; 74.4.4.7)
- building said second draft measurement model (Davis; section 31.4.1-31.4.2 and Figure 31.1). (i.e. building second, third, nth models)

Davis discloses iterative model creation (i.e. building first and second draft measurement models), but does not expressly disclose executing a first prioritization process determining for each metric a relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with each other metric. Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17,26-31,34-38) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Davis with the teachings of Feurer. As suggested by Feurer, one would have been motivated to include these features so that the resultant system and method reflects the values of the customers (e.g. stakeholders) while establishing the right balance between conflicting goals. (Feurer: par. 1)



(K) As per claim 13, Davis teaches the step of building a solution responsive to inputs from a measurement module and a requirements validation module (Davis; Figure 5.1, section 5.4.1.3 and 5.4.1.7).

(L) As per claim 14, Davis teaches the validating step further comprising executing a comparison between existing measurements and proposed measurements in response to inputs from: a current process design, a proposed process design, a to-be organizational design, and a to-be process design (Davis; sections 3.4.1.2-3.4.1.4, and sections 4.4.2.1-4.4.2.2).

(M) As per claim 15, Davis claims the transferring step further comprising an external interface design, a tools configuration, a requirement specification (i.e., contract measurement business policy), a report, end-user training materials, and a deployment plan (Davis; Figure 24.3, section 5.1, section 48.3, lines 1-5, section 35.4.3.4 section 47.3, lines 1-10, section 75.1 and 75.4.5, section 76.4.4.1-76.4.4.5).

(N) System claim 16 differs from claim 12, in that claim 12 contains a method recited as a series of function steps whereas claim 16 contains features recited in a "means plus function" format. As the method of step claim 12 has been shown to be disclosed or obvious by the combined teachings of Davis and Feurer, it is readily apparent that the "means" to accomplish those method steps is obvious in view of the prior art. As such, the limitations recited in claim 16 are rejected for the same reasons given for method claim 12 and incorporated herein.

(O) As per claim 17, Davis teaches a method for executing a page analysis comprising:

- a) mapping current system and data and identifying gaps in a computer database (Davis; sections 3.4.1.1-3.4.1.4; sections 5.1-5.4 (all), Figure 5.1);
  - b) identifying in said computer database missing measurement data (Davis; sections 3.4.1.1-3.4.1.4; sections 5.1-5.4 (all), Figure 5.1);
  - c) identifying redundant (i.e., nonproductive) measurements (Davis; section 3.4.1.3);
  - d) identify impact to organizational structure (Davis; section 13.4.2, lines 11-19);
- and
- e) identify other requirements for measurement success (Davis; section 24.4.7.4).

(P) Claims 22-26 differs from claims 1, 4, 8, 12, and 17, respectively, in that claims 1, 4, 8, 12, and 17 contain a method recited as a series of function steps whereas claims 22-26 contain features recited as a computer readable medium encoding instructions for performing the steps of claims 1, 4, 8, 12, and 17 . As the method of step claims 1, 4, 8, 12, and 17 have been shown to be computer-implemented and disclosed or obvious by the combined teachings of Davis and Feurer, it is readily apparent that the "computer readable medium" to accomplish those method steps is obvious in view of the prior art. As such, the limitations recited in claim 22-26 are rejected for the same reasons given for method claims 1, 4, 8, 12, and 17 respectively, and incorporated herein.

10. Claims 8-9, 18-19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Nagai et al. (US 2001/0025247 A1) and in further view of Feurer.

(A) As per claim 8, Davis teaches a method for defining the measures of performance of an IT organization comprising:

- a) metric and measurement tools and parent and child measurement categories stored in a repository (i.e. computer database) (Davis; tables 5.1 and sections 5.4.1, 35.1-35.4);

- c) implementing contract measurements (Davis; section 76.1); and

- d) using and maintaining measurements (Davis; section 77.4.3 and 78.4.1).

Davis teaches the method of claim 8 as explained above. However, Davis fails to teach the selecting measurements from the repository. Nagai details the selection of measurements from a repository (Nagai; Figure 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the human resources measurements selected from a repository of Nagai to the performance measurement system of Davis with the motivation of "supporting preliminary estimation of the effects of a system and a configuration proposal at a planning stage of construction and/or improvement of an information system" (Nagai; paragraph 0002, lines 7-10).

Claim 8 further recites the step of building a measurement model work product further comprising:

- building said first draft measurement model (Davis; Figure 31.1, and section 31.4; 74.4.4.7)
- building said second draft measurement model (Davis; section 31.4.1-31.4.2 and Figure 31.1). (i.e. building second, third, nth models)

Davis discloses iterative model creation (i.e. building first and second draft measurement models), but does not expressly disclose executing a first prioritization process determining for each metric a relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with each other metric. Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17,26-31,34-38) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Davis with the teachings of Feurer. As suggested by Feurer, one would have been motivated to include these features so that the resultant system and method reflects the values of the customers (e.g. stakeholders) while establishing the right balance between conflicting goals. (Feurer: par. 1)

(B) As per claim 9, Davis teaches categories including, human resources, quality, customers, cost and schedule, process and productivity, output behaviors (Davis; tables 11.1, 12.1, 18.1, 35.1-35.3).

(C) As per claim 18, Davis teaches a conical method for defining a measurement model work product; comprising:

a) articulating envisioned business goals and behaviors (Davis; section 8.2, lines 1-5);

b) defining goals and behaviors in a database of existing contract measures (Davis; table 5.1 and section 5.4.1.9;

However, Davis fails to teach c) the selection of measurements from the database of contract measures. Nagai teaches the selection of measurements from a repository (Nagai; Figure 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the human resources measurements selected from a repository of Nagai to the performance measurement system of Davis with the motivation of "supporting preliminary estimation of the effects of a system and a configuration proposal at a planning stage of construction/improvement of an information system" (Nagai; paragraph 0002, lines 7-10);

Claim 18 further recites the step of building a measurement model work product further comprising:

- building said first draft measurement model (Davis; Figure 31.1, and section 31.4; 74.4.4.7)
- building said second draft measurement model (Davis; section 31.4.1-31.4.2 and Figure 31.1). (i.e. building second, third, nth models)

Davis discloses iterative model creation (i.e. building first and second draft measurement models). However, Davis fails to teach the prioritization and the

balancing of the measurements and does not expressly disclose executing a first prioritization process determining for each metric a relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with each other metric. Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17,26-31,34-38) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the teachings of Davis and Nagai with the teachings of Feurer. As suggested by Feurer, one would have been motivated to include these features so that the resultant system and method reflects the values of the customers (e.g. stakeholders) while establishing the right balance between conflicting goals. (Feurer: par. 1)

(D) As per claim 19, Davis teaches a system for defining a measurements model work product comprising,

a) a database for articulating envisioned business goals and behaviors (Davis; Figure 5.1, and section 5.4.1.9);

However, Davis does not teach b) a second database to hold behaviors and goals selected from an existing contract measures; or c) a means for selecting measurements from the second database; or Nagai teaches a separate definition information database (102) and a system configuration database (103), the selection of measurements from a repository, and the weighting of the measurements (Nagai;

Figures 1 and 12, and page 8, paragraph 0125). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the human resources measurements selected from a repository of Nagai to the performance measurement system of Davis with the motivation of “supporting preliminary estimation of the effects of a system and a configuration proposal at a planning stage of construction/improvement of an information system” (Nagai; paragraph 0002, lines 7-10).

Davis further discloses that the system for iterative model creation (i.e. building first and second draft measurement models) has the following capabilities (i.e. the system comprises components to perform the following):

- building said first draft measurement model (Davis; Figure 31.1, and section 31.4; 74.4.4.7)
- building said second draft measurement model (Davis; section 31.4.1-31.4.2 and Figure 31.1). (i.e. building second, third, nth models)

Davis does not expressly disclose that the system comprises a prioritizing and balancing means for measurements in the work model. Davis also does not disclose that the system executes a first prioritization process determining for each metric a relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with each other metric. Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17,26-31,34-38) The system/method of

Feurer also discloses that weighted hierarchies are established for the measurements in the work model. (i.e. means for prioritizing and balancing measurements) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the teachings of Davis and Nagai with the teachings of Feuerer to include a first and second prioritization process and prioritizing and balancing means. As suggested by Feuerer, one would have been motivated to include these features so that the resultant system and method reflects the values of the customers (e.g. stakeholders) while establishing the right balance between conflicting goals. (Feurer: par. 1)

(E) Claim 27 differs from claims 18, in that claim 18 contains a method recited as a series of function steps whereas claim 27 contain features recited as a computer readable medium encoding instructions for performing the steps of claim 18. As the method of step claim 18 has been shown to be computer-implemented and disclosed or obvious by the combined teachings of Davis, Nagai and Feuerer, it is readily apparent that the "computer readable medium" to accomplish those method steps is obvious in view of the prior art. As such, the limitations recited in claim 27 are rejected for the same reasons given for method claim 18, respectively, and incorporated herein.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



- Adiano et al (USPN 5,278,751) teaches a method and system adapting the manufacturing process to meet customer needs (i.e. goals).
- Ouimet et al (WO 98/53416) teaches a method and system for optimization of enterprise planning models.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703)305-9588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

RP

RP  
December 28, 2003

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600